

## **REMARKS**

In view of the amendments and remarks that follow, Applicants respectfully submit that the application is in condition for allowance. Accordingly, applicants request reconsideration of the application, withdrawal of the rejections and objections of record and issuance of a Notice of Allowance.

The Office notes that Claims 1-7, 16 and 17 are pending in the application, all of which stand rejected for the reasons of record. However, the Office appears to have missed new Claim 18 added in the prior paper which includes a long list of species of the invention. Claims 1, 3, 4, 17 and 18 have been amended to put the claims in condition for allowance.

### **Claim Objections**

Applicants acknowledge the Office's comments that the objection of Claim 1 has been withdrawn due to the "modification of the claim 1 is the amendment." (sic) The Office appears to be objecting to the negative proviso introduced in the prior response. The Office notes that the applicant is required to cancel the new matter in the reply to this Office Action.

Additionally, claim 17 (actually 18) is objected to as including a non-elected species in the list of compounds.

Applicants, while disagreeing that the negative proviso needs to be removed as constituting new matter, have amended claim 1 to remove the proviso. Applicants would like to point out that it is routine to either delete directly or by proviso, prior art that would impact the patentability of an invention. Applicants request that the Office provide support for this objection.

Claim 18 (not 17 as noted by the Office) has been amended to remove the species that falls outside the elected Group I.

### **Rejections Under 35 U.S.C. § 112, first paragraph**

The Office notes that the rejection of Claims 1-7 and 16 under 35 U.S.C. § 112, first paragraph, has been withdrawn in view of the amendments made to the claims. However, it is noted that the claims continue to be rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office notes that the negative proviso added to Claim 1 lacks description in the original specification. While disagreeing with the Office's contention, Claim 1 has been amended to remove the "negative proviso" to expedite the prosecution of the remaining subject matter.

### **Rejections Under 35 U.S.C. § 112, second paragraph**

The Office notes that the rejection of Claims 1-7 and 16 under 35 U.S.C. § 112, second paragraph, has been withdrawn in view of the amendments made to the claims.

Claim 17 is rejected because the phrase relating to the R2 and R3 substituents is considered to be vague and indefinite because of the use of Markush language and the term "or".

Claim 17 has been amended to delete the phrase "selected from" to put the claim in condition for allowance.

#### **Rejections Under 35 U.S.C. § 102**

Claims 1 and 2 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Plattner, U.S. Patent 4,389,416. The Office notes that the rejection under 35 U.S.C. 102 (b) is maintained for the reasons of record.

Applicants have amended Claim 1 by removing the negative proviso and by deleting alkyl as an R10 substituent. The amendment to Claim 1 is considered to overcome the rejection under 102(b) and withdrawal of the rejection is respectfully requested.

In view of the foregoing, Applicants submit that the application, as amended, is in condition for allowance and courteously solicit a Notice of Allowance.

If any fee due is not accounted for herein, please charge such fee to Deposit Account No. 19-3880. If any extension of time is required and not petitioned for, such extension is hereby petitioned for, and it is requested that any fee due in connection therewith be charged to the aforementioned Deposit Account.

If a direct personal communication would advance the prosecution of this application, please contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

/elliott korsen/  
Elliott Korsen  
for Applicants  
Reg. No. 32,705

Date: February 13 2008  
Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-4741